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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/105,150	06/26/1998	ANGELO T. DONFRANCESCO	36087	5213

23820 7590 05/03/2002

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EXAMINER

FIGUEROA, FELIX O

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 05/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 23

Application Number: 09/105,150
Filing Date: June 26, 1998
Appellant(s): DONFRANCESCO ET AL.

MAILED

MAY 03 2002

GROUP 2800

Jeffrey J. Howell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/19/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that all claim stand or fall separately is not agreed with because the claims have been rejected as a group under similar basis and therefore should be treated as a group. Additionally, applicant has not provided reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). Further yet, applicant has presented similar and grouped arguments for all independent claims.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

3,068,445

Crowther

9-1959

(10) *Grounds of Rejection*

The following grounds of rejection are applicable to the appealed claims:

Claims 1, 4-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crowther (US 3,068,445). This rejection is set forth in prior Office Action, Paper No. 20.

(11) *Response to Argument*

Regarding applicant's arguments, in page 5 paragraphs 1-3, that Crowther "does not disclose, teach or render obvious a stake extending in the circular and substantially planar end of a screw shank and along a cord of the second end transverse to the longitudinal axis of a screw", please note that Crowther discloses a deformation (36) extending in the circular and substantially planar end of the screw shank (26), such deformation extends along a chord of the second end that is transverse to the longitudinal axis of the screw (16). Clearly, Figure 5 of Crowther shows the deformation extending in the circular end substantially planar second end, which is transverse to the longitudinal axis of the screw.

Crowther also teaches (col.2 lines 25-31) that the second end can be distorted by peening or other suitable means. The American Heritage® Dictionary of the English Language, Fourth Edition, defines "peen" as "the end of a hammerhead opposite the flat striking surface, often wedge-shaped or ball-shaped and used for chipping, indenting, and metalworking", Copyright © 2000 by Houghton Mifflin Company. Crowther clearly suggest that the deformation can be made by different and suitable

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means, or by peening, which definition includes the use of wedge-shaped hammerheads for indenting. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the deformation, at the circular and substantially planar end of the screw shank, as a stake in order to achieve the same purpose.

Additionally, The American Heritage® Dictionary of the English Language, Fourth Edition, defines "chord" as "a line segment that joins two points on a curve", Copyright © 2000 by Houghton Mifflin Company. Please note that any deformation made on the second end of the shank, as suggested by Crowther, will extend along a "chord" of the second end.

Furthermore, and regarding applicant's arguments that "the free extremity" disclosed by Crowther can refer to "the longitudinal side", it is noted that the fact that such language could be interpreted in different ways does not obviate the manner in which Crowther defines it, as clearly shown in Figure 2.

Regarding applicant's arguments, in the first full paragraph of page 6 through the first full paragraph in page 7, that Crowther "fails to contain any motivation", please note that Crowther states that the deformation at the second end can be formed by "other suitable means". The American Heritage® Dictionary of the English Language, Fourth Edition, defines "suitable" as "appropriate to a purpose or an occasion", Copyright © 2000 by Houghton Mifflin Company. Crowther clearly suggested that other means could be used to suit the desired purpose or occasion.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding applicant's arguments, in the second full paragraph of page 7, that there is no evidence that the structure provided by Crowther will perform equally, please note that Crowther shows the use of the deformation, so that the screw cannot be completely removed from the base. Therefore, the provided structure will achieve the same purpose and solve the same problem, as those stated by the applicant, so performing equally.

Regarding applicant's arguments, in the last paragraph of page 7, please note that Crowther clearly discloses (in col.2 line 27) that the deformation is formed in the last thread, thus allowing maximum extend and usage of the screw.

Additionally, regarding applicant's arguments that "the stake is quicker and easier to form", please note that this arguments are moot, since they do not have basis in the original disclosure and thus cannot be considered.

Regarding applicant's arguments, in paragraph 1 of page 8, that there is no suggestion to combine the references, the examiner recognizes that obviousness can

only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Crowther clearly suggested that other means could be use to suit the desire purpose or occasion.

Regarding applicant's arguments, in paragraph 2 of page 8, that "a deformation with a wedge shaped peen will not necessarily extend along a chord of the second end", please note the a possibility of failure does not obviate a modification as an obvious to one of ordinary skill in the art. Additionally, Figure 2 clearly shows that the deformation on the second end of the shank extends transverse to the longitudinal axis of the screw. Furthermore, any deformation made on the second end of the shank, as suggested by Crowther, will extend along a "chord" of the second end.

Regarding applicant's arguments, in the second full paragraph in page 9, please note that the last thread of Crowther is disposed in the second end of the screw shank, thus forming a deformation on the last thread will place the deformation on the second end as shown in Figure 2.

Regarding applicant's arguments, in the last paragraph in page 9, please note that the fact that the specification discloses that the terminal assembly is "easy to manufacture" and that the stake can be "easily formed", does not support applicant's arguments that "the stake is quicker and easier to form". It is further noted, that the

deformation formed does not requires any complex or time-consuming process.

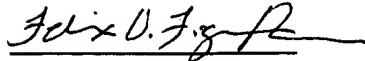
Therefore, since Crowther shows an assembly that is easily manufactured and formed, applicant's structure does not provide any further advantage or improvement over the known prior art.

Regarding applicant's arguments, in the last paragraph of page 10, specifically on claim 4, please note that it would have been an obvious matter of design choice to offset the deformation/stake form the longitudinal axis of the shank, since applicant has not disclosed that such arrangement solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with regardless of the location of the deformation/stake with respect to the longitudinal axis of the shank. Additionally, Crowther discloses, in Figure 2, the reduce width as required by claim 5; the backing plane (14), as required by claims 6-8 and 12-14; the external thread as required by claim 10; and the shank being in a backing plate central aperture.

Specifically, on claims 9 and 15, it is noted that the features upon which applicant relies to differentiate (i.e., the contact is not frictionally coupled) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

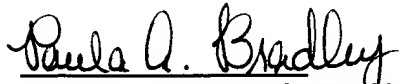
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Felix O. Figueroa
April 29, 2002

Conferees



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